

Remarks

The Office Action withdrew claims 1-36, 68 and 77 from consideration. Claims 37-49, 52 and 59 were additionally withdrawn from consideration.

Claims 51, 53, 54, 58-67 and 69-76 were indicated as being allowable if rewritten. Claims 78-82 were allowed. Applicants respectfully thank the Examiner for the indication of allowable subject matter in this case.

Applicant respectfully submits that the election of species is clearly erroneous. For example, claim 52 was withdrawn from consideration. However, claim 52 depends from claim 51 which was indicated as containing allowable subject matter. Thus, claim 51 is generic to both the elected species and the species corresponding to claim 52. Since the Office Action acknowledges the allowability of a generic claim (claim 51), applicant is entitled to recapture a reasonable number of species. Similarly, claim 77 was withdrawn from consideration but claim 76 was indicated as being allowable. Claim 76 is generic as to both the elected species and any species corresponding to claim 77. Claim 76 was indicated as being allowable. Since the Office Action acknowledges the allowability of a generic claim (claim 76), applicant is entitled to recapture a reasonable number of species. Reconsideration and withdrawal of the election of species requirement is respectfully requested.

Claims 50 and 55 were rejected under 35 U.S.C. Section 103 (a) as being unpatentable over Kochamba et al. (6,251,065) in view of Sterman et al. (5,735,290).

Kochamba discloses an arm 98 and a stabilizer 10. It is not clear how Kochamba is being read on claim 50, but the Office Action does mention that trocar sheaths 10, 12, 14 and 16 of Sterman et al.

Sterman discloses clip applier 36 extending through sheath 12, a grasper 32 extending through sheath 10 and thoroscope 34 extending through sheath 12. The thoroscope 34 may also extend through sheath 16. It is respectfully submitted that the thoroscope 34, clip applier 36 and grasper 32 are different than the arm 98 and stabilizer 10 of Kochamba. Because of the differences in these systems, one of ordinary skill in the

AMENDMENT

Serial No. 10/675,815

Filing Date: September 30, 2003

Title: METHODS AND APPARATUS PROVIDING SUCTION-ASSISTED TISSUE
ENGAGEMENT THROUGH A MINIMALLY INVASIVE INCISION

Page 25

Dkt.: P0010855.01

art could not reasonably anticipate that such diverse systems could be combined in order to arrive at the present invention. As a result, it is respectfully submitted that the rejection of claims 50 and 55 should be withdrawn.

With respect to claim 55, the Office action took the position that "the shaft is position in an operative vector in 3-D space and rigidly maintained...". However, Kochamba discloses that the arm 98 is attached to bedpost 104 or sternal retractor 102. Kochamba does not disclose applicant's claimed invention. As a result, claim 55 further comprise allowable subject matter that is not disclosed by any combination of Kochamba et al. and Stermen et al.

Please charge the fee of \$210.00 for the addition of one additional independent claim to Deposit Account No. 13-2546.

A supplemental information disclosure statement and a petition for a one month extension of time accompany this response.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 13-2546.

Respectfully submitted,

Date: December 31, 2007

By Jeffrey J. Hohenshell
Jeffrey J. Hohenshell
Reg. No. 34,109
Senior Patent Attorney
MEDTRONIC, INC.
710 Medtronic Parkway
Minneapolis, MN 55432
Tel. 763-505-8426
Fax. 763-505-8436
Customer No. 27581